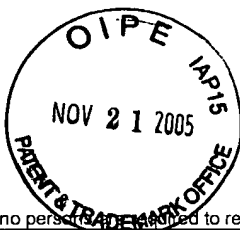


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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

2140146000004/06296.010

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on _____

Signature _____

Typed or printed name **Everett D. Robinson**

Application Number

09/383,279

Filed

Aug. 26, 1999

First Named Inventor

Wharton, Brian K.

Art Unit

3625

Examiner

Fadok, Mark A.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number **50,911**

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Everett D. Robinson

Typed or printed name

801-532-1234

Telephone number

Nov. 17, 2005

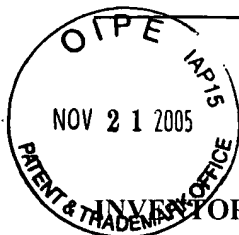
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

INVENTORS: Wharton, Brian K.

TITLE: Electronic Commerce System and Method

FILING DATE: August 26, 1999 **EXAMINER NAME:** Mark A. Fadok

SERIAL NO.: 09/383,279 **GROUP ART UNIT:** 3625

DOCKET: 2140146000004/06296.010

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REASONS FOR PRE-APPEAL BRIEF REVIEW

Applicant provides the following summary of arguments made to the claims rejections outstanding in the above referenced application. All page references are to the Response to Office Action dated Nov. 17, 2005 and filed concurrently with this paper.

Claims rejected under 35 U.S.C. § 102(e) relying on U.S. Pat. No. 5,966,697 ("Ferguson"):

Claim 15: Ferguson does not anticipate this claim because it fails to disclose steps A, B, D, E and F of that claim. (see pgs. 8-10.) Ferguson does not disclose:

- the transmission of a packet from a vendor commerce system to a common transaction processing system as in step D. Ferguson does not disclose how selections arrive to her "checkout processor", but there is at least one way that selections could arrive not from a vendor commerce system and this step is not inherently disclosed.

- an E-Commerce Portal as recited in steps A and B, but rather a list of merchants within a custom software program at the customer's computer.

- the segmenting or aggregation of product order items as in step F. Rather, the Ferguson system appears to maintain selections from different merchants separately in their own logical containers.

- the repetition of steps A, B and D as in step E.

Claim 16 (dependent on claim 15): Ferguson does not anticipate because it fails to disclose steps G1 and G2 of that claim. More particularly, Ferguson does not disclose vendor-specific processing rules, customer-specific processing rules, databases containing those rules, nor the use or querying of those rules to process transaction order items. (see pgs. 10-12.)

Claim 17: Ferguson does not anticipate because it fails to disclose all the claim limitations, particularly (1) a payment proxy interface, (2) runtime payment logic and (3) a plurality of payment connection modules. (see pgs. 13-15.)

Claim 18: Ferguson does not anticipate because it fails to disclose all the claim limitations, particularly (1) a payment proxy system, (2) a local and a global shopping basket and (3) an E-Commerce portal. (see pg. 15.)

Claim 19: Ferguson does not anticipate because it fails to disclose all the claim limitations, particularly (1) merchant-specific transaction processing rules and (2) a transaction processor in combination with a plurality of back-end processing systems. (see pg. 16.)

Claim 20 (dependent on claim 19): Ferguson does not anticipate because it fails to disclose all the claim limitations of this claim and claim 19, particularly an E-Commerce portal. (see pg. 16.)

Claim 21 (dependent on claim 19): Ferguson does not anticipate because it fails to disclose all the claim limitations of this claim and claim 19, particularly a local shopping basket at a vendor commerce system in combination with a global shopping basket at a transaction processor. (see

pg. 16.)

Claim 22 (dependent on claim 19): Ferguson does not anticipate because it fails to disclose all the claim limitations of this claim and claim 19, particularly rules of any kind or a customer directory stored at a vendor commerce system. (see pgs. 16-17.)

Claim 23 (dependent on claim 19): Ferguson does not anticipate because it fails to disclose all the claim limitations of this claim and claim 19, particularly the transmission of a packet from a vendor commerce system to a common transaction processing system nor a transaction interface. (see pg. 17.)

Claims rejected under 35 U.S.C. § 103(a) relying on U.S. Pat. No. 5,966,697 (“Ferguson”) and U.S. Pat. No. 5,966,697 (“Nerlikar”):

Claim 24 (dependent on claims 19 and 23): The arguments of rejection fail to make out a prima facie case of obviousness because (1) all of the claim limitations are not taught by the combination of Ferguson and Nerlikar, (2) there is no motivation to combine the references and (3) there is no expectation of success. (see pgs. 17-19.) In summary, neither reference discloses an order header, nor an order header that contains merchant authentication information or customer authentication information. A motivation to combine is lacking because one of ordinary skill would not think to combine the two references because the combination would merely encumber the operation of the commerce system (by requiring the transference and use of RFID tags or badges) without providing a benefit (the combination would not result in a system that is effectively more secure than could be achieved through the security provided by credit card numbers.) The TCP/IP protocol provides no motivation, because that protocol, although it does use a type of header, does not provide a security benefit because the protocol is not encrypted and relies on datagrams, and further provides no suggestion to combine an electronic shopping system with an RFID identification system. (see pgs. 17-19.) An expectation of

success is absent, because the combination would not provide the alleged benefit of efficient means for providing rudimentary transaction information (Ferguson already uses the Internet, and thus uses at least the IP protocol), rather the use of RFID tags would encumber the shopping operation by requiring the securement of physical RFID tags in addition to the security provided by credit card numbers, which would not be efficient.

Claims rejected under 35 U.S.C. § 103(a) relying on U.S. Pat. No. 5,966,697 (“Ferguson”) and the collection of articles called “Clearcommerce.”:

Claims 27-29 (dependent on claims 19 and 26): The arguments of rejection fail to make out a prima facie case of obviousness because (1) all of the claim limitations are not taught by the combination of Ferguson and Nerlikar, (2) there is no motivation to combine the references and (3) there is no expectation of success. (see pgs. 19-21.) The limitations of (1) a plurality of back-end processing systems, (2) a back-end processor interface for processing and routing stored transaction requests to the plurality of back-end systems, (3) merchant-specific processing rules, (4) a database storing those rules, (5) a plurality of payment verification systems and any of (6a) a payment proxy system, (6b) a transaction capture database or (6c) a payment proxy interface in combination with runtime payment logic and a plurality of payment connection modules are not taught by either of Ferguson or Clearcommerce.

Claims 26 and 30-33 (dependent on claim 19): The arguments of rejection fail to make out a prima facie case of obviousness because (1) all of the claim limitations are not taught by the combination of Ferguson and Nerlikar, (2) there is no motivation to combine the references and (3) there is no expectation of success. (see pgs. 19-21.) The limitations of (1) a plurality of back-end processing systems, (2) a back-end processor interface for processing and routing stored transaction requests to the plurality of back-end systems, (3) merchant-specific processing rules, (4) a database storing those rules and any of (5a) a plurality of payment verification systems, (5b) customer specific transaction processing rules stored to a database, (5c) merchant

specific transaction processing rules stored to a database, or (5d) runtime scripting information determining how to process a particular transaction for a customer or merchant are not taught by either of Ferguson or Clearcommerce.

Additionally, there is no motivation to combine Ferguson with Clearcommerce, because the articles of Clearcommerce are press releases and contain virtually no information that would be useful to implement an E-commerce system. Likewise, there is no reasonable expectation of success because the combination would not result in a different implementation than that disclosed by Ferguson due to a lack of implementary information.

Applicant further challenges this rejection on grounds that the obligation created by 35 U.S.C. § 132(a) of a statement of the reasons for this rejection has not been met.

Claims rejected under no grounds.

Claim 25: According to the Office Action Summary, claim 25 is rejected. The office action fails, however, to offer any grounds for rejection. Applicants traverse this rejection on grounds as stated for claim 19, and further that the Office has acted in violation of 35 U.S.C. § 132(a), which requires a statement of the reasons for this rejection.